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NUTTER MCCLENNEN & FISH LLP			ARAJ, MICHAEL J	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,173

Filing Date: December 31, 2003

Appellant(s): ZALENSKI ET AL.

Ronald E. Cahill
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 24, 2007 appealing from the

Office action mailed March 7, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0055031

LIM

3-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 11, 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Markworth et al. (US Patent Publication Number 2003/0199872), cited by applicant.

Markworth et al. disclose various embodiments of an implant implantation device comprising a frame having a trigger mechanism, 514, an outer sleeve, 400, mechanically coupled to the frame, an inner shaft, 300, having a grabber, 206, for mechanically engaging an implant, wherein the inner shaft is slidably disposed along a major axis of the inner shaft within the outer sleeve, whereby actuation of the trigger extends the grabber from the outer sleeve to thereby release the implant, and a retaining spring element, 600, for directing the grabber toward a closed position, whereby the grabber is substantially contained within the outer sleeve when the trigger is released (see figures 6A, 6B, 7A and 7B).

Art Unit: 3775

The device further includes a drag adjustment screw, 108, rotatably coupled to the frame for providing tension between the trigger mechanism and the inner shaft, and a including a depth control member, 200, slidably coupled to the outer sleeve, wherein the depth control member provides a predetermined insertion depth of the implant (see figures 6A, 6B, 7A and 7B). The device also includes a protrusion, 112, on the outer sleeve for slidably engaging a distraction instrument (see figures 6A, 6B, 7A and 7B). Markworth et al. further disclose a knob, 712, mechanically coupled to the outer sleeve, wherein the knob is capable of causing the outer sleeve and the inner shaft to be rotated about the frame (see figures 7A and 7B and paragraphs 0057-0060). The grabber includes grabber tips for mechanically engaging an implant wherein the grabber tips include a first pair of slots for engaging a first engagement tab of the implant and a second pair of slots for engaging a second engagement tab of the implant and wherein a sizing slot is located between the first pair of slots and the second pair of slots to allow for a variation of tab and slot dimensional differences (see figure1C). The grabber further includes markings, e.g. 111, to identify a position of an implant, and the grabber is capable of being removably coupled to the inner shaft (see figures 6A, 6B, 7A and 7B).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Markworth et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation

does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markworth et al. (US Patent Publication Number 2003/0199872) in view of Lim (US Patent Publication Number 2005/0055031).

Markworth et al. disclose the claimed invention except the marking being a pin. Lim discloses an implant implantation device and teaches the use of an indicator pin to indicate the positioning of the clamping members relative to one another (see paragraph 0064). Since the grabber of Markworth et al. is elastic such that application of a force causes the fingers to separate (see paragraph 0042), it would have been obvious to one skilled in the art at the time the invention was made to construct the device of Markworth et al. with the grabber

including an indicator pin, in view of Lim, in order to indicate the positioning of the clamping members relative to one another.

(10) Response to Argument

A. Markworth Fails to Disclose an Outer sleeve that is Mechanically coupled to a Frame as recited in Element (ii)

Applicant argues that Markworth is not mechanically coupled to the frame, but rather is connected to the distal end of the slide for sliding movement. The definition of coupled can be taken from dictionary.com defining "to fasten, link, or associate together in a pair or pairs" (definition 8). It is clear that the outer sleeve (400) is coupled/associated with the frame of Markworth (Fig. 1B). If the outer sleeve was not mechanically coupled to the frame then the device of Markworth would be able to function properly.

B. Markworth Fails to Disclose an Inner Shaft Having a Grabber as Recited in Element (iii)

Applicant argues that the cited grabber (206) in Markworth is not on the "inner shaft". All that is required of element (iii) of claim 1 is that an inner shaft has a grabber. It does not require that the grabber be connected to the inner shaft. The inner shaft has a grabber (206) in association with the inner shaft (300) wherein the inner shaft slidably disposed along a major axis of the inner shaft within the outer sleeve. Even though the grabber (206) may be connected to element 200, the claim still reads on Markworth. The inner shaft has a grabber.

C. Markworth Fails to Disclose an Inner Shaft Slidably Disposed within an Outer Sleeve as Further Recited in Element (iii)

Applicant argues that Markworth is not slidably disposed within the outer sleeve because the outer sleeve is pivotally connected to the distal end of the inner shaft and it does not and cannot slide with respect to it. It can be seen with respect to Figures 7A and 7B that the inner shaft slides within the outer sleeve (400) of Markworth because the grabber changes its distance from element 418. Therefore, the inner shaft is slidably disposed within an outer sleeve of Markworth.

D. Markworth Fails to Disclose that Actuation of a Trigger is Effective to Extend a Grabber from an Outer Sleeve to thereby release an Implant as Further Recited in Element (iii)

Actuation of the trigger will extend the grabber from the outer sleeve of the device to release the implant. When the trigger (500) is actuated in a direction towards element 218 the device will grab onto an implant and the grabber moves towards the outer sleeve (400). But when the trigger (500) is actuated in the opposite direction, then the trigger extends the grabber (206) from the outer sleeve to thereby release the implant.

E/F. Markworth Fails to Disclose a Retaining Element for Directing the Grabber Toward a Closed position as Recited in Element (iv) and Fails to Disclose a Grabber that is Substantially Contained Within an Outer Sleeve When a Trigger is Released

The retaining spring element, 600, of Markworth et al. does direct a grabber, 206, toward a closed position via slide, 300, and sleeve, 400, whereby the grabber is substantially contained within the outer sleeve when the trigger is released. (see paragraph 0051, particularly lines 10-23). Movement of the retaining spring element, 600, results in the advancement of the slide, 300, and sleeve, 400, which in turn directs the grabber, 206, toward a closed position (see paragraphs 0054 and 0055, particularly lines 6-9 of paragraph 0054 and lines 4-6 of paragraph 0055)

a. Dependent Claim 3 is Separately Patentable Over Markworth

Because Markworth Fails to Disclose a Knob Mechanically Coupled to an Outer Sleeve and Causing the Outer Sleeve and Inner Shaft to be Rotated About the Frame

Markworth shows a knob (712) that is mechanically coupled to an outer sleeve. The applicant is silent to the knob being directly coupled to the outer sleeve. When the device is actuated, the knob moves in a pivoting direction (D), as seen in Figure 7B.

b. Dependent Claim 5 is Separately Patentable Over Markworth

Because Markworth Fails to Disclose at Least One Protrusion on an Outer Sleeve

The protrusion is considered to be element 112, on the outer sleeve for slidably engaging a distraction instrument (see figures 6A, 6B, 7A and 7B).

c. Dependent Claim 6 is Separately Patentable Over Markworth

Because Markworth Fails to Disclose a Depth Control Member Slidably Coupled to an Outer Sleeve

All that is required for this claim is a member that is able to be used for depth control of an implant. Element 200 is able to be used as a depth control device even if it is done manually.

d. Dependent Claims 12, 13 and 14 are Separately Patentable Over Markworth Because Markworth Fails to Disclose a Grabber With at Least One Marking to Identify the Position of the Implant.

The marking "111" appears to be a typo. Element 211 can be identified as a marking. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

e. Dependent Claim 15 is Separately Patentable Over Markworth Because Markworth Fails to Disclose a Grabber that is Removable Coupled to an Inner Shaft.

As disclosed in discussion "B" above, Markworth a grabber is coupled to an inner shaft by way of association. To make something removable is only a matter of taking the device apart.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Araj

/Michael J Araj/

Examiner, Art Unit 3775

Conferees:

Eduardo Robert

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733

Tom Barrett



The handwritten signature of Tom Barrett is written in cursive ink. It appears to read "Tom Barrett" above a horizontal line, with "TQAS" and "TC 3700" written below it, also separated by a horizontal line.